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10/635,436	08/07/2003	Alejandro Wiechers	200207414-1	8520
22879 7590 05/28/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER SINGH, SATWANT K				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
05/28/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/635,436

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

SATWANT K. SINGH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on 14 February 2008.

Response to Arguments

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/635,452. Although the conflicting claims are not identical,

they are not patentably distinct from each other because claims 1-19 of the instant application are directed towards performing automated shipping of a printed document, whereas claims 1-19 of the referenced copending application are directed towards automated packaging of a printed document. It appears to the examiner that these limitations (shipping in view of packaging) are obvious variations of each other since prior to shipping the documents, packaging instructions need to be known so that the documents are packaged according to the user's instructions. Therefore, the print provider needs to know how the document should be packaged before it can be sent out to the person who ordered it. The packaging instructions are an obvious predecessor to the shipping instructions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (US 6,714,964) in view of Warmus et al. (US 5,963,968) and Ryan et al. (US 7,206,087).

7. Regarding Claim 1, Stewart et al teach a method of managing workflow in a commercial printing environment including a designer location (client side of the network

300a) and a print service provider location (printer side 300c), said method comprising: creating a press ready file at the designer location (Fig. 7, S600-640) (user creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using the updated device information from the print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67); submitting said press ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4).

Stewart et al fail to teach a method, verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure printing substantially as designed; and performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file.

Warmus et al teach a method, verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure printing substantially as designed (control unit to control and makeready files and cause one or more demand printing system to print desired pages) (col. 5, lines 44-59); and performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file (printed pages printed by the demand printing system supplied to a finishing apparatus) (col. 5, lines 60-67, col. 6, lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Warmus to provide the necessary verification needed to insure the correct output is shipped.

Stewart et al and Warmus et al fail to teach a method comprising: establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device; and verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information.

Ryan et al teaches a method comprising: establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device (Fig. 10 Steps 101) (a table of printer capabilities and constraints is retrieved from the VJTDB and a table of finisher/assembler capabilities and constraints is retrieved from the VJTDB) (col. 18, lines 43-52); and verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information (Fig. 10 Step 103) (PMC using the retrieved lists of all of the capabilities and constraints of the devices described in the VJTDB to generate a list of all possible specific paths or threads, by which the retrieved devices can implement the operations and attributes identified in the job model) (col. 18, lines 57-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart and Warmus with the teaching of Ryan to verify that the printer is capable of outputting the print job prior to submitting the print job to the particular printer.

8. Regarding claim 2, Stewart et al teach a method, wherein said step of creating a press ready file at the designer location further comprises performing automated remote shipping setup of said press ready file to remotely select the desired shipping options for said press ready file when printed at said print service provider location (servicing on the completed jobs includes shipping or delivery of the documents) (col. 8, lines 39-44).

9. Regarding Claim 3, Stewart et al teach a method, wherein said step of verifying, at said print service provider location, further comprises performing automated remote shipping setup (servicing on the completed jobs includes shipping or delivery of the documents) (col. 8, lines 39-44).

10. Regarding Claim 4, Stewart et al teach a method, wherein said step of automated shipping is performed and wherein an automated shipping device is used to ship said printed output in accordance with shipping instructions in said press ready file (Fig. 7C, S670 and S675, package shrink wrapped and sent for delivery) (col. 9, lines 1-4).

11. Regarding Claim 5, Stewart et al disclose a method, wherein said step of correcting includes reading shipping instructions prepared at the designer location and preparing appropriate corresponding instructions for an actual shipping device to be

used at the print service provider location (Fig. 7C, S670 and S675, package shrink wrapped and sent for delivery) (col. 9, lines 1-4).

12. Regarding Claim 6, Stewart et al teach a method, wherein said step of correcting further comprising updating a job ticket corresponding to said press ready file (Fig. 7B, S650 and Fig. 7C, S655, print ready file is transferred to the production facility and queued to an available printer) (col. 8, lines 62-67, col. 9, lines 1-4).

13. Regarding Claim 7, Stewart et al teach a computer readable medium encoded with a program product for managing workflow in a commercial printing environment including a designer location (client side of the network 300a) and a print service provider location (printer side 300c), said product comprising machine-readable program code for causing, when executed, a machine to perform the following method steps: creating a press ready file at the designer location (Fig. 7, S600-640) (user creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using updated device configuration information from the print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67); submitting said press ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4).

Stewart et al fail to teach a computer readable medium encoded with a program product, verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if

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not, correcting said press ready file to ensure printing substantially as designed; and performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file.

Warmus et al teach a program product, verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure printing substantially as designed (control unit to control and makeready files and cause one or more demand printing system to print desired pages) (col. 5, lines 44-59); and performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file (printed pages printed by the demand printing system supplied to a finishing apparatus) (col. 5, lines 60-67, col. 6, lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Warmus to provide the necessary verification needed to insure the correct output is shipped.

Stewart et al and Warmus et al fail to teach a program product comprising: establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device; and verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information.

Ryan et al teaches a program product comprising: establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device (Fig. 10 Steps 101) (a table of printer capabilities and constraints is retrieved from the VJTDB and a table of finisher/assembler capabilities and constraints is retrieved from the VJTDB) (col. 18, lines 43-52); and verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information (Fig. 10 Step 103) (PMC using the retrieved lists of all of the capabilities and constraints of the devices described in the VJTDB to generate a list of all possible specific paths or threads, by which the retrieved devices can implement the operations and attributes identified in the job model) (col. 18, lines 57-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart and Warmus with the teaching of Ryan to verify that the printer is capable of outputting the print job prior to submitting the print job to the particular printer.

14. Regarding claim 8, Stewart et al teach a program product, wherein said step of creating a press ready file at the designer location further comprises performing automated remote shipping setup of said press ready file to remotely select the desired shipping options for said press ready file when printed at said print service provider location (servicing on the completed jobs includes shipping or delivery of the documents) (col. 8, lines 39-44).

15. Regarding Claim 9, Stewart et al teach a program product, wherein said step of verifying, at said print service provider location, further comprises performing automated remote shipping setup (servicing on the completed jobs includes shipping or delivery of the documents) (col. 8, lines 39-44).

16. Regarding Claim 10, Stewart et al teach a program product, wherein said step of automated shipping is performed and wherein an automated shipping device is used to ship said printed output in accordance with shipping instructions in said press ready file (Fig. 7C, S670 and S675, package shrink wrapped and sent for delivery) (col. 9, lines 1-4).

17. Regarding Claim 11, Stewart et al disclose a program product, wherein said step of correcting includes reading shipping instructions prepared at the designer location and preparing appropriate corresponding instructions for an actual shipping device to be used at the print service provider location (Fig. 7C, S670 and S675, package shrink wrapped and sent for delivery) (col. 9, lines 1-4).

18. Regarding Claim 12, Stewart et al teach a program product, wherein said step of correcting further comprising updating a job ticket corresponding to said press ready file (Fig. 7B, S650 and Fig. 7C, S655, print ready file is transferred to the production facility and queued to an available printer) (col. 8, lines 62-67, col. 9, lines 1-4).

19. Regarding Claim 13, Stewart et al teach a system of managing workflow in a commercial printing environment including a designer location (client side of the network 300a) and a print service provider location (printer side 300c), said system comprising: means for creating a press ready file at the designer location (Fig. 7, S600-640) (user

creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using updated device configuration information from the print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67); means for submitting said press ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4).

Stewart et al fail to teach a system, means for submitting said press ready file to the print service provider location via an electronic network; means for verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure printing substantially as designed; and means for performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file.

Warmus et al teach a system means for submitting said press ready file to the print service provider location via an electronic network; means for verifying, at said print service provider location, that said press ready file will print at said print service provider location as designed at the designer location and, if not, correcting said press ready file to ensure printing substantially as designed (control unit to control and makeready files and cause one or more demand printing system to print desired pages) (col. 5, lines 44-59); and means for performing automated shipping using, if created, said corrected press ready file, else using said verified press ready file(printed pages

printed by the demand printing system supplied to a finishing apparatus) (col. 5, lines 60-67, col. 6, lines 1-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Warmus to provide the necessary verification needed to insure the correct output is shipped.

Stewart et al and Warmus et al fail to teach a system comprising: means for establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device; and means for verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information.

Ryan et al teaches a system comprising: means for establishing a link to the print service provider location from the designer location and obtaining updated device information including functional capabilities of a desired printing device and at least one production device (Fig. 10 Steps 101) (a table of printer capabilities and constraints is retrieved from the VJTDB and a table of finisher/assembler capabilities and constraints is retrieved from the VJTDB) (col. 18, lines 43-52); and means for verifying that required elements for completion of a production of a print job at the print service provider location are present in the print job based on the updated device information (Fig. 10 Step 103) (PMC using the retrieved lists of all of the capabilities and constraints of the devices described in the VJTDB to generate a list of all possible specific paths or

threads, by which the retrieved devices can implement the operations and attributes identified in the job model) (col. 18, lines 57-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart and Warmus with the teaching of Ryan to verify that the printer is capable of outputting the print job prior to submitting the print job to the particular printer.

20. Regarding Claim 14, Stewart et al teaches a method, wherein the required elements present in the print job at the designer location include instructions for shipping (Fig. 7B, S630, user inputs shipping and payment data on the interface) (col. 8, lines 58-60).

21. Regarding Claim 15, Stewart et al teaches a method, wherein the press ready file is corrected at the print service provider location by including corrected instructions for shipping (Fig. 7B, S635-640) (shipping and payment data are verified and file is combined with the finishing and binding options to create a print ready file) (col. 8, lines 60-65).

22. Regarding Claim 16, Stewart et al teaches a program product, wherein the required elements present in the print job at the designer location include instructions for shipping (Fig. 7B, S630, user inputs shipping and payment data on the interface) (col. 8, lines 58-60).

23. Regarding Claim 17, Stewart et al teaches a program product, wherein the press ready file is corrected at the print service provider location by including corrected instructions for shipping (Fig. 7B, S635-640) (shipping and payment data are verified

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and file is combined with the finishing and binding options to create a print ready file) (col. 8, lines 60-65).

24. Regarding Claim 18, Stewart et al teaches a system, wherein the required elements present in the print job at the designer location include instructions for shipping (Fig. 7B, S630, user inputs shipping and payment data on the interface) (col. 8, lines 58-60).

25. Regarding Claim 19, Stewart et al teaches a system, wherein the press ready file is corrected at the print service provider location by including corrected instructions for shipping (Fig. 7B, S635-640) (shipping and payment data are verified and file is combined with the finishing and binding options to create a print ready file) (col. 8, lines 60-65).

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATWANT K. SINGH whose telephone number is (571)272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Satwant K. Singh
Examiner
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/David K Moore/

Supervisory Patent Examiner, Art Unit 2625